

REMARKS

The present communication is filed in response to the Official Action mailed December 12, 2006, rejecting claims 1-7 and 10-19 pending in the application ("Official Action"). Of the pending claims, claims 1, 6, 11, and 16 are independent claims. All the other claims pending in the application, namely claims 2-5, 7, 10, 12-15, and 17-19, depend from one of the independent claims.

Claim Amendments

Claim 6 has been amended to correct its form.

Claim 11 has been amended by replacing the phrase "having coupled" with --being coupled-- as suggested by the Examiner. Applicant respectfully submits that this amendment to claim 11 is to its form.

Claim Rejections — 35 U.S.C. § 112

All the claims pending in the application were rejected under 35 U.S.C. § 112, second paragraph, by the Examiner as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Official Action 2-3.) In this regard, the examiner noted that with regard to the independent claims (i.e., claims 1, 6, 11, and 16) "it is unclear what the scope of the term add-on register is." (Id. 3) Although the Examiner acknowledges that the claims included the new limitation of providing an add-on register and some structural interconnection requirements, he indicated that "there is nothing in the claims that discloses any particular functionality that is associated with this register." (Id.) Further, the Examiner indicated that since it was "unclear if the label 'add-on' is intended to incorporate any functionality or if the term is simply a label to differentiate the add-on register from 'a register'" in the

claims, the term was interpreted to have its broadest scope, i.e., "the term is simply a label." (*Id.*)

"Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 U.S.P.Q. 597 (C.C.P.A. 1971)." *Manual of Patent Examining Procedure* ("M.P.E.P.") § 2173.04, at 2100-213. The term "add-on register" is fully supported by the original disclosure. For example, FIG. 1 and its accompanying description show and describe a connection between the add-on register 25, system control circuit 29 and memory register 22. (See also paragraph [0022] for example.)

The M.P.E.P. further states that: "If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of the scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph." See M.P.E.P. § 2173.04, at 2100-213. This term is not so broad that it does not set forth that which applicant regards as their invention as evidenced by statements outside of the application as filed. The Examiner has treated the term as a label "to differentiate the add-on register from 'a register' in the first limitation of the claim." (Official Action 3.) This label serves a similar function in claims that use labels such as "first," "second," etc., to differentiate between elements. Thus, although broad, the scope of the subject matter embraced by the claims is clear.

In that regard, the Examiner has interpreted the term "add-on" by giving it its broadest scope. Such scope is supported by the application as originally filed. FIG. 1 shows a memory register 21 and an add-on register 25. Thus, the use of term in the claim is consistent with its use in the disclosure. M.P.E.P. § 2173.04, at 2100-211 ("As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA

1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.").

Therefore, the scope of the term "add-on register" is clear. Its breadth should not be equated with indefiniteness. Thus, for at least this reason, the claims meet all the requirements of 35 U.S.C. § 112.

Claim Rejections — 35 U.S.C. § 103

The Examiner rejected claims 16 and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,164,549 to Richards ("*Richards*") in further view of U.S. Patent No. 6,213,392 to Zuppichich ("*Zuppichich*"). Claims 1-7 and 10-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Richards* and further in view of *Zuppichich* and U.S. Patent No. 6,901,299 to Whitehead et al. ("*Whitehead*").

In rejecting the claims, the Examiner states that *Richards* "teaches detection of a requested function, by comparing the function to the code of the function to be loaded with the functions already loaded in the electronic device (Fig[.], 5A, elements 520-531, and column 7, lines 19-61)." (Official Action 4.) The Examiner also acknowledges that *Richards* "does not explicitly teach providing an add-on register in the electronic device, the add-on register being coupled to the register through a system control circuit, the system control circuit being operable to supply a control signal for driving a memory controller connected to the register." But the Examiner asserts "[h]owever, it is inherent to *Richards* that there must be at least one other register in the device to hold the data to be compared in the comparing operation and the operation code for doing the comparing operation." (*Id.*)

Applicant respectfully traverses the Examiner's rejection. There is more than one way to carry out a compare operation.

For example, in lieu of using a separate register, *Richards* could also use a digital comparator having one input hardwired with a fixed value. Indeed, *Richards* states that "the routine checks whether the application identification number associated with the command, `load_file_command.application_id`, is present in the operating system control information, `os_control_info.application_id`." (*Richards* col.7 ll.24-29.) This operation could be carried out by hardwiring the identification number present in the operating system to one input of a comparator. The application number associated with the command may then be provided to the other input of the comparator and the compare operation carried. This would not require two separate registers.

More specifically, *Richards* file mode type determination may be done using a hardwired digital comparator. (*Id.*, ll. 38-44.) For example, "shell" could be the hardwired input. If the other input is anything other than "shell," then the comparator then outputs a false result; e.g., a "0". This operation does not require two registers as is asserted by the examiner.

Richards is silent as to the details of how the compare operation is carried out. Therefore, it is equally likely that the compare operation could be carried as indicated by applicant in this response.

In asserting the *Zuppicich* reference, the examiner further asserts that "[i]t is explicit that the codes represent functions, and inherent that these functions are associated with different devices, or there would be no need to check for them." (Office Action 6.) Even if the codes in *Zuppicich* represented functions, those functions may be associated with different features that may be provided by a single device. They need not be associated with different devices. In addition, as indicated by *Richards*, different codes may represent different versions of the standards that are associated with smart card technology.

(*Richards* col.1 11.54-59.) Thus, it is not inherent in *Zuppicich* that functions are associated with different devices. *Richards* makes that clear.

As discussed above, in rejecting the claims, the Examiner relies heavily on inherent disclosures in the prior art references. These inherent disclosures are, however, mere possibilities. "The fact that a certain result or characteristics may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result in optimization of conditions, not what was necessarily present in the prior art)." M.P.E.P. § 2112, 2100-47. Indeed, the purported inherent disclosure relied on by the Examiner is not necessarily present in the prior art.

Applicant respectfully submits that the claims are not rendered obvious for at least the reasons given above. In particular, the features of the claims that that Examiner ascribes as being inherent in *Richards* are not necessarily present in the reference. In addition, none of the other references make up for the deficiencies in *Richards*.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

Application No.: 09/834,025

Docket No.: SONYJP 3.0-154

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By 

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